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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/285,249	04/02/1999	JOHN S. HENDRICKS	5200	3419

7590 01/28/2003

ALDO NOTO
DORSEY & WHITNEY LLP
1001 PENNSYLVANIA AVE N.W.
SUITE 300, SOUTH TOWER
WASHINGTON, DC 20004

EXAMINER

GRANT, CHRISTOPHER C

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 01/28/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/285,249

Applicant(s)

HENDRICKS ET AL. *PH*

Examiner

Christopher Grant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 20-21 and 23-25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The disclosure fails to support the following limitations now recited in claim 20:

“c) sending a first authorization code to a file server to enable set top terminal to receive a requested program;

d) spooling...server;

e) authorizing viewing or delivering of said requested program; and

f) downloading a second authorization code when the requested program is scrambled, wherein the second authorization code descrambles said scrambled requested program”.

The disclosure fails to support the following limitations now recited in claim 25:

“c) sending a first authorization code to a file server;

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d) spooling...server;

e) authorizing viewing or delivering of said requested program;

f) downloading a second authorization code, wherein the second authorization code descrambles said requested program".

The specification at page 15, lines 11-22 describes that the authorization component (236) processes subscriber requests and prompts the file server (215) to spool the requested program and **alternatively** "the file server 215 may be instructed to transmit an authorization code to the subscriber to enable descrambling or reception of a specific program...". Therefore, the specification **does not** support the steps of providing a first **and** second authorization codes. Rather, the specification describes the authorization component spools the requested program **or** transmit an authorization code for descrambling. Moreover, the specification describes only one authorization code and there is no support for simultaneous use of first and second authorization codes.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wunderlich et al. (Wunderlich) and Farry et al. (Farry) (of record).

Considering claim 1, Wunderlich discloses an apparatus for video on demand programs comprising:

- a) a receiver (51) to receive requests for video on demand programs (col. 9, lines 1-3);
- b) a network manager (51) to process said program request (col. 9, lines 4-14);
- c) a file server (52), coupled to the network manager (51), wherein the file server spools the requested program via device (53).

Although Wunderlich discloses authorizing the subscriber to view the requested program (col. 9, lines 15-20 and 23-26), he fails to specifically disclose an authorization component to transmit an authorization code to enable set top terminals to receive a requested program as recited in the claim.

Farry discloses an apparatus (figure 16) for video on demand programs comprising an authorization component (1670 and/or 501) that transmits a notification signal (e.g. an authorization code or identification) to a level 1 gateway server (1640) for the advantage of authorizing service to a subscriber. See column 11, lines 1-35.

It would have been obvious to one of ordinary skill in the art to modify Wunderlich's system (if necessary) to include an authorization component to transmit an authorization code to

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enable set top terminals to receive a requested program, as taught by Farry, for the typical advantage authorizing service to a subscriber.

Claim 2 is met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses a network manager (51) that comprises a processor inherently having an instruction memory for executing the processing of the program request as described at col. 9, lines 4-14.

Claim 3 is met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses a network manager (51) that comprises a processor having control software that compile the program requests to determine if a channel is available for a requesting subscriber as described in col. 9, lines 15-25.

Claims 4-5 are met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses that file server deliver at least one requested program to the requesting subscriber.

Claim 6 is met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses that programs are stored in MPEG format at col. 7, lines 60-65.

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Claim 7 is met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses that the request for VOD programs are from set top terminals (14) described throughout the reference including but not limited to col. 5, lines 15-20 and col. 9, lines 1-40.

Claim 8 is met by the combined systems of Wunderlich and Farry because the transferring of any signal (including an authorization code) between two equipments has to include an interface device. For example, a printer interface card is necessary in a computer to send data to the printer and an interface is needed in a computer in order to receive input data from a keyboard. Therefore, one of ordinary skill in the art would readily recognize that an interface is a necessary device in the transfer of data between equipments.

Claim 9 is met by the combined systems of Wunderlich and Farry as described in the rejections of claims 3 and 8.

Claims 10 and 17 are met by the combined systems of Wunderlich and Farry as described in the rejections of claims 3 and 8, since Farry's authorization component (501) has to receive a request in order to issue authorization.

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Claim 11 is met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses a network manager (51) that comprises a processor inherently having an instruction memory for executing the processing of the program request as described at col. 9, lines 4-14.

Claim 12 is met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses a network manager (51) that comprises a processor having control software that compile the program requests to determine if a channel is available for a requesting subscriber as described in col. 9, lines 15-25.

Claim 13 is met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses that the request for VOD programs are from set top terminals (14) described throughout the reference including but not limited to col. 5, lines 15-20 and col. 9, lines 1-40.

Claims 14-15 are met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses that file server deliver at least one requested program to the requesting subscriber.

Claims 16 and 18-19 are met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses that programs are stored in MPEG format at col. 7, lines 60-65. Note that MPEG programs are digital programs.

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Response to Arguments

5. Applicant's arguments filed 11/15/2002 have been fully considered but they are not persuasive.

Response to Applicant's arguments

A) Applicant argues (with respect to claims 1, 9, 10 and 17) that neither Wunderlich nor Farry teaches ***“said file server spools said requested program or downloads a second authorization code when the requested program is scrambled, wherein the second authorization code descrambles said scrambled requested program”*** on pages 5-6 of the amendment filed 11/15/2002.

In response, Applicant should note that claims 1, 9, 10 and 17 are written in alternative language. In that, each of the claims requires limitation a or limitation b. Claims 1, 9, 10 and 17 each recites the following:

(a) “said file server spools said requested program”

or

(b) “downloads a second authorization code when the requested program is scrambled, wherein the second authorization code descrambles said scrambled requested program”.

The Examiner posits that the combined systems of Wunderlich and Farry teach all the limitations of claims 1, 9, 10 and 17 including limitation (a) “said file server spools said requested program”. Wunderlich and Farry do not have to teach limitation (b) because each of the claims is written in alternative language. As a result, Applicant's arguments are not persuasive.

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B) Applicant argues (with respect to claims 20-24) that neither Wunderlich nor Farry, individually or in combination discloses or teaches “ *downloading a second authorization code when the requested program is scrambled, wherein the second authorization code descrambles said scrambled requested program*” on page 6 (6th paragraph) of the amendment filed 11/15/2002.

In response, the Examiner agrees that the rejection of Wunderlich and Farry in the previous Office Action does not indicate steps e) **and** f) limitations of revised claim 20. However, claims 20-25 are rejected under 35 USC 112 first paragraph as described above.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Conclusion

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry and for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Grant whose telephone number is (703) 305-4755. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306 0377.



Christopher Grant
Primary Examiner
January 25, 2002